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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,190	12/14/2000	Tetsuo Shibuya	14043 (JP919990270US1)	9159

7590 12/14/2004

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

LY, CHEYNE D

ART UNIT PAPER NUMBER

1631

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/737,190

Applicant(s)

SHIBUYA, TETSUO

Examiner

Cheyne D Ly

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2 and 12.

Claim(s) withdrawn from consideration: 1 and 3-11.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The claim amendment for changing the limitation of "into" to "with" in claim 2, line 7, has not been entered because said amendment raises new issues that would require further consideration and/or search. Applicant has noted that "[a] similar revision, changing "into" to --with-- was made in the previous AMENDMENT to claim 2, line 10. It is noted that step (i) and step (ii) are distinct steps are recited in claim 2. The amendment for changing the limitation of "into" to "with" in claim 2, line 7, raises new issues that would require further consideration and/or search because the new limitation recites a different means for manipulating information. Further, step (ii) which has been previously amended is directed to manipulating data which "indicates if that said same variable is not present upstream..." While, step (i) is directed to manipulating data which "represents a location of the same variable if it is present upstream..." Therefore, the new limitation as recited in claim 2, line 7, raises new issues that would require further consideration and/or search.

Continuation of 5. does NOT place the application in condition for allowance because: Claims 2 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is maintained with respect to claims 2 and 12, as recited in the previous office action mailed September 15, 2004.

RESPONSE TO ARGUMENT


Applicant's argument by pointed to disclosure in the instant specification has been fully considered and found to be unpersuasive because the pointed to disclosure does not specifically define the limitation of "array" or "target array." The pointed to examples in the specification directed to "DNA or RNA base array" do not specifically define the limitation of "array" or "target array" that have been identified as being vague and indefinite. Further, the pointed disclosure of "[for] a gene sequence, such as DNA or RNA base array" does not resolved the unclarity of whether the limitation of "array" is a mathematical array having a plurality of elements, or the representation of the elements generated an array apparatus.

Claims 2 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kadashevich et al. (US005369577A). This is prior art rejection is directed to an array apparatus comprising data elements as discussed in the above 35 USC §112, Second Paragraph, rejection.

This rejection is maintained with respect to claims 2 and 12, as recited in the previous Office Action, mailed September 15, 2004.

RESPONSE TO ARGUMENTS

Applicant argues that Kadashevich et al. does not disclose the limitations of claims 2 and 12 as exemplified by the instant specification on page 4, lines 11-19, and page 7, lines 4-11. It is noted that the examples pointed to by Applicant do not specifically define or limit the limitations as recited in claim 2 or 12. It is noted that claims are given their broadest reasonable interpretation consistent with the specification. However, the instant claims are not limited to the critical steps that have been cited from the specification by Applicant as limitations that are not disclosed by Kadashevich et al. As cited by the MPEP, the court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (MPEP §2111 [R-1]).


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SEP 16 2004